THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte MARTIN COLE, THOMAS T. HOWARTH and CHRISTOPHER READING

_____

Appeal No. 99-0624
Application 07/749,482[1]

_____

HEARD: May 3, 1999

_____

Before GARRIS, OWENS and LIEBERMAN, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

---

[1] Application for patent filed August 15, 1991. According to the appellants, the application is a continuation of Application 07/210,339, filed June 23, 1988, now abandoned; which is a continuation of Application 05/569,007, filed April 17, 1975, now abandoned.

This is an appeal from the examiner's final rejection of claims 112-118, 120-122 and 128-131, which are all of the claims remaining in the application.

THE INVENTION

Appellants' claimed invention is directed toward pharmaceutical compositions which are useful for $-lactamase inhibition in humans and animals and which include clavulanic acid or a pharmaceutically acceptable salt thereof, in combination with a pharmaceutically acceptable carrier or in pharmaceutically acceptable form. Claims 112 and 128 are illustrative and read as follows:

112. A pharmaceutical composition useful for effecting $-lactamase inhibition in humans and animals which comprises a $-lactamase inhibitory amount of a pharmaceutically acceptable salt of clavulanic acid, in combination with a pharmaceutically acceptable carrier.

128. A $-lactamase inhibitory pharmaceutical composition comprising solid clavulanic acid or a pharmaceutically acceptable salt thereof in a $-lactamase inhibitory amount in pharmaceutically acceptable form.

THE REFERENCE

Eli Lilly & Co. (Lilly) 1,315,177 Apr. 26, 1973

THE REJECTIONS

Claims 112-118, 120-122 and 128-131 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lilly, and under 35 U.S.C. § 103 as being obvious over Lilly.

Rejection under 35 U.S.C. § 102(b)

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The examiner argues that clavulanic acid inherently was produced and isolated by Lilly (answer, pages 3-24). This argument is deficient in that it does not address the limitation in each of the independent claims which requires that either clavulanic acid (claim 112) or a pharmaceutically acceptable salt thereof (claims 113 and 120) be in combination

with a pharmaceutically acceptable carrier, or be in a pharmaceutically acceptable form (claim 128), and it is not apparent where Lilly discloses each of these limitations. We therefore do not sustain the rejection under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

The examiner argues that since Lilly's "other antibiotic substances" have been found to include clavulanates, it would have been *prima facie* obvious to one of ordinary skill in the art to purify the clavulanates and use them in conventional forms for administration (answer, pages 24-25). This argument is not well taken because the examiner has not established that it was known in the art that Lilly's "other antibiotic substances" include clavulanic acid or clavulanates. The examiner argues that Lilly's characterization of the antibiotic substances as such indicates that the substances were separated and tested sufficiently to determine that they are antibiotics and include clavulanic acid and clavulanates

(answer, page 6). This argument is not persuasive because it is based purely on speculation, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). Hence, we do not sustain the rejection under 35 U.S.C. § 103.

DECISION

The rejections of claims 112-118, 120-122 and 128-131 under 35 U.S.C. § 102(b) as being anticipated by Lilly, and under 35 U.S.C. § 103 as being obvious over Lilly, are reversed.

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)
)
)
) BOARD OF PATENT
TERRY J. OWENS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
PAUL LIEBERMAN)
Administrative Patent Judge)

TJO/pgg
Janice E. Williams
Smithkline Beecham Corp.
Corporate Patents-U.S. UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939